

Remarks/Arguments:

Applicants thank the Examiner for the courtesy of the July 25, 2007 telephone interview. The substance of the interview is set forth in the following remarks.

Claim Rejection Under 35 U.S.C. §112, second paragraph

Claim 15 stands rejected under 35 U.S.C. §112, second paragraph, as indefinite. Applicants respectfully submit that the claim as amended address the examiner's concerns and respectfully request withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. §102 and §103

Claims 8 and 11-15 stand rejected under 35 U.S.C. §102 as anticipated by PCT Publication No. WO 01/73312 (Jungbecker et al.) (with U.S. Patent No. 6,767,305 provided as an English language equivalent). Claim 10 stands rejected under 35 U.S.C. §103 as unpatentable over Jungbecker et al. in view of U.S. Patent No. 5,127,315 (Gerard et al.) Applicants traverse these rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"To establish a *prima facie* case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2143. Additionally, as set forth by the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), it is necessary to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed.

Independent claim 8 recites an "actuating unit for an electromechanically actuated disc brake for automotive vehicles, which is disposed on a brake caliper wherein two friction linings respectively cooperating with a side face of a brake disc are arranged in a manner displaceable to a limited extent, with a first of said friction linings being arranged so as to be directly movable into engagement with the brake disc by means of an actuating element, through the actuating unit, while the other friction lining is movable into engagement with the brake disc through the action of a reaction force applied by the brake caliper, wherein the actuating unit comprises an electric motor and at least one reduction gear operatively arranged between the

electric motor and the first friction lining, and with the reduction gear being formed of a threaded drive accommodated in a gear housing and including a cylindrical guide piece that is provided with a sensor device for sensing the reaction force, wherein the guide piece has a reduced thickness of material or an aperture in an area of attachment of the sensor device, and a prefabricated sensor module forming the sensor device, the sensor module including a carrier element on which a measuring element and contacting means are arranged, the carrier element arranged outside the guide piece in the area of attachment or within or above the aperture."

In paragraph 4, the Office Action indicates that the sensor (43) of Jungbecker et al. can be considered a sensor module. Paragraph 6 of the Office Action indicates that element 29 can be considered a carrier element arranged outside a guide piece.

As explained during the interview, element 29 of Jungbecker et al. is in fact the guide member (see col. 3, lines 62-65 and Figs. 1 and 2) and can not be considered a carrier element arranged outside of itself. To the contrary, Jungbecker et al. explains at column 4, lines 35-37 of the '305 patent that "measuring elements 43, e.g. wire strain gauges, are arranged on the surface of the guide member 29. . . ." During the interview, the Examiner acknowledged this shortcoming of Jungbecker et al.

Since each and every element as set forth in the claim is not found, either expressly or inherently described, in Jungbecker et al., the reference fails to anticipate the claimed invention. Gerard et al. is cited as teaching laser-welding in a brake assembly and does not overcome the shortcomings of Jungbecker et al.

It is respectfully submitted that independent claim 8 is condition for allowance. Claims 10-15 each depend from claim 8 and should each be allowed for at least the reasons set forth above.

It is respectfully submitted that each of the pending claims is in condition for allowance. Early reconsideration and allowance of each of the pending claims are respectfully requested.

If the Examiner believes an interview, either personal or telephonic, will advance the prosecution of this matter, it is respectfully requested that the Examiner get in contact with the undersigned to arrange the same.

Respectfully submitted,



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